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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,437	03/25/2004	Masami Suwama	2004-0483A	6940

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EXAMINER	
FLETCHER III, WILLIAM P	
ART UNIT	**PAPER NUMBER**
1762	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/808,437	SUWAMA ET AL.	
	Examiner	Art Unit	
	William P. Fletcher III	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 16-21* is/are pending in the application.

4a) Of the above claim(s) *20 and 21* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 16-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/23/2007 has been entered.

Response to Amendment

2. Claims 1-13 and 16-21 remain pending.

Election/Restrictions

3. Claims 20 and 21 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 05/02/2005.

Response to Arguments

4. Applicant's arguments filed 01/23/2007 have been fully considered but they are not persuasive.

Applicant has amended the claims to require the curing step to occur at a temperature of 60-70°C for 10-25 min. Applicant argues that this represents a lower temperature and shorter time than conventionally employed in the art to give a tack-free clear coating. Applicant further argues that the cited prior art neither teaches nor

suggests curing at this temp/time and that such a curing scheme represents an unexpected result weighing in favor of non-obviousness.

While the Examiner does not disagree that the cited prior art fails to explicitly recite the claimed temp/time, such a scheme would, nonetheless, have been obvious to one of ordinary skill in the art. The time and temperature of a paint curing process are, both individually and synergistically, well-known result-effective variables. For example, a paint coating may be cured in a shorter time by employing a higher temperature, but the artisan must determine whether such an arrangement will result in satisfactory film quality. Likewise, lower temperatures requiring longer times may be employed, but the artisan must contend with how longer curing times impact process efficiency. Consequently, it would have been obvious to one of ordinary skill in the art to optimize the temp/time curing scheme by routine experimentation, absent unexpected results demonstrating the criticality of the claimed temp/time scheme.

With respect to the unexpected nature of the claimed temp/time curing scheme, Applicant argues:

> It would, however, have been quite difficult even for a skilled person in the art to develop a clear paint which would meet this requirement.

and

> According to Applicants' invention, the clear paint unexpectedly results in reduction of energy consumption be [*sic*] painting line or productivity improvement by increased conveyor running speed.

Both of these arguments are unsupported by any evidence in the record. The Examiner reminds Applicant that the arguments of counsel cannot take the place of evidence in

the record[1] and that evidence of unexpected results must be supported by an affidavit or declaration.[2] Consequently, the claimed temp/time remains obvious over the cited art of record.

In considering Applicant's arguments, the Examiner makes the following further observations:

A. Applicant states that the clear paint is "fully cured" in the claimed temp/time. The Examiner notes that the claims do not require that the clear paint be fully cured. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

B. Applicant alleges that neither Rink nor Marutani teach or suggest the idea or technical advantages of the Applicants' invention. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant.[3]

[1] MPEP 716.01(c)(II)
[2] MPEP 2145(I)
[3] MPEP 2144

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. **Claims 1, 3-13, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rink et al. (US 6,013,739 A) in view of Marutani et al. (US 6,040,009 A) and Ido et al. (US 2002/0013398 A1).**

A. These references are applied as set-forth under this heading in the prior Office action.

B. It would have been obvious to one of ordinary skill in the art to optimized the temp/time of the curing scheme by routine experimentation, for the reasons set-forth above.

8. **Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rink et. al, Marutani et al., and Ido et al., as applied to claim 1 above, and further in view of Asahina et al. (US 5,817,732 A) and Croft (US 5,688,860 A).**

A. Rink, Marutani, and Ido are applied herein again as set-forth under this heading in the prior Office action.

B. Asahina and Croft render this claim obvious for the reasons set-forth in the prior Office action.

Conclusion

9. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William Phillip Fletcher III
Primary Examiner
Art Unit 1762

March 14, 2007